

RECEIVED
CENTRAL FAX CENTER

JUN 17 2004

OFFICIAL

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Scott A. Hermreck, et al.
APPLICATION NO.: 09/805,321
FILING DATE: March 13, 2001
TITLE: SYSTEM AND METHOD FOR TRACKING CHARITABLE DEDUCTIONS
EXAMINER: Bryan J. Jaketic
GROUP ART UNIT: 3627
ATTY. DKT. NO.: 16319-08245

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Box DAC, Commissioner for Patents, P. O. BOX 1450, ALEXANDRIA, VA 22313-1450, at the facsimile number of (703) 872-9306.

Dated: 6/17/04

By: [Signature]

Robert R. Sachs, Reg., No.: 42, 120

BOX DAC
COMMISSIONER FOR PATENTS
P. O. BOX 1450
ALEXANDRIA, VA 22313-1450

PETITION TO WITHDRAW HOLDING OF ABANDONMENT
UNDER 37 CFR 1.181 AND MPEP § 711.03(C)

Applicants respectfully request reconsideration and withdrawal of the Notice of Abandonment issued on May 24, 2004, stating that Applicants had not filed a timely response to the Office Action mailed on October 23, 2003 (a copy of the Notice of Abandonment of May 24, 2004 is enclosed).


On March 22, 2004, Applicants timely filed an Amendment in response to the Office Action of October 23, 2003, a copy of which is attached. The Amendment was received by the PTO on March 26, 2004 as indicated on the copy of the postcard, as attached.

Accordingly, since Applicants filed, and the PTO received, a proper response to the October 23, 2003, Office Action, it is respectfully requested that the holding of abandonment be withdrawn.

If any additional information is required, please contact the Attorney for Applicants at the telephone number below.

Respectfully submitted,
Scott A. Hermreck, *et al.*

Dated: 6/17, 2004

By: 
Robert R. Sachs, Reg. No. 42, 120
Attorney for Applicants
Fenwick & West LLP
Silicon Valley Center
801 California Street
Mountain View, CA 94041
Tel.: (415) 875-2358
Fax: (415) 281-1350

COPY

Date Mailed: March 22, 2004 A/v/Sec: PB:cal Filing Date: March 13, 2001

Application No.: 09/805,321

Docket No.: 16319-08245

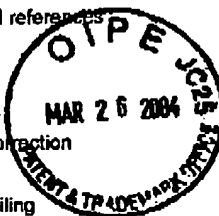
Applicant(s): Scott A. Hemreck et al.

Title: System and Method for Tracking Charitable Deductions

Please imprint Patent Office "date stamp" hereon to indicate receipt and return card to addressee.

☐ ___ pages of Specification, Claims & Abstract☐ Nonpublication Request under 35 U.S.C. 122(b)(2)(B)(i).☐ ___ sheets of formal drawings☐ Provisional Application Cover Sheet☐ New Utility Application Transmittal☒ Transmittal☒ Fee Transmittal (in duplicate)☐ Declaration☐ Assignment & Recordation Cover Sheet☐ Power of Attorney☐ RCE Transmittal☐ Application Data Sheet☐ Check in the amount of \$☒ Amendment (14 Pages)

Other _____

☐ Response to Notice Of Missing Parts☐ Request for Corrected Filing Receipt☐ Request for Correction of Recorded Assignment☐ IDS, PTO/SB/08A, and cited references☐ Issue Fee Transmittal☐ Letter to Chief Draftsperson☐ Formal Drawings: ___ sheets☐ Request for Certificate of Correction☐ Notice of Appeal☒ First Class Certificate of Mailing

OFFICIAL

**FENWICK & WEST LLP**

SAN FRANCISCO OFFICE | 275 BATTERY ST., SUITE 1500 | SAN FRANCISCO, CA 94111

TEL 415.875.2300 | FAX 415.281.1350 | WWW.FENWICK.COM

RECEIVED
CENTRAL FAX CENTER**JUN 17 2004****FACSIMILE TRANSMISSION****CONFIDENTIAL****DATE:** June 17, 2004**CLIENT-MATTER No.:** 16319-08245**To:**

| NAME | FAX No. | PHONE No. |
|--|----------------|----------------|
| Box DAC, Commissioner for Patents, P. O. BOX 1450, Alexandria, VA 22313-1450 | (703) 872-9306 | (703) 305-9285 |

FROM: Robert R. Sachs**PHONE:** (415) 875-2410**NUMBER OF PAGES WITH COVER PAGE:** 24**ORIGINAL WILL NOT FOLLOW****MESSAGE:****PETITION TO WITHDRAW HOLDING OF ABANDONMENT
UNDER 37 CFR § 1.181 AND MPEP § 711.03(c)**

Applicants: Scott A. Hermreck, et al.
App. No.: 09/805,321
Filing Date: March 13, 2001
Title: System and Method For Tracking Charitable Deductions
Atty. Dkt. No. 16319-08245

CAUTION - CONFIDENTIAL

THE INFORMATION CONTAINED IN THIS FACSIMILE MESSAGE IS PRIVILEGED AND CONFIDENTIAL INFORMATION INTENDED ONLY FOR THE USE OF THE INDIVIDUAL OR ENTITY NAMED ABOVE OR THEIR DESIGNEE. IF THE READER OF THIS MESSAGE IS NOT THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISSEMINATION, DISTRIBUTION OR COPY OF THIS COMMUNICATION IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR PLEASE IMMEDIATELY NOTIFY US BY TELEPHONE AND RETURN THE ORIGINAL MESSAGE TO US AT THE ABOVE ADDRESS VIA THE U.S. POSTAL SERVICE. THANK YOU.

**IF YOU DO NOT RECEIVE ALL OF THE PAGES, OR IF THEY ARE NOT CLEAR,
PLEASE CALL Larisa Burshteyn AT (650) 943-5373 AS SOON AS POSSIBLE.**

PTO/SB/21 (modified)


Approved for use through xx/xx/xx, OMB 0651-0031


Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

| | | | | |
|--|------------------------|--|------------------------|-------------------|
| TRANSMITTAL FORM (to be used for all correspondence during pendency of filed application) | 0001/PTO Rev. 10/95 | U.S. Department of Commerce Patent and Trademark Office | Application Number | 09/805,321 |
| | | | Filing Date | March 13, 2001 |
| | | | First Named Inventor | Scott A. Hemmreck |
| | | | Group Art Unit Number | 3627 |
| | | | Examiner Name | Bryan J. Jaketic |
| Total Number of Pages in This Submission | | 23 | Attorney Docket Number | 16319-08245 |

| ENCLOSURES (check all that apply) | |
|---|--|
| <input type="checkbox"/> Fee Transmittal Form (in duplicate) <input type="checkbox"/> Check Enclosed | <input type="checkbox"/> Issue Fee Transmittal |
| <input type="checkbox"/> Return Receipt Postcard | <input type="checkbox"/> Letter to Chief Draftsperson |
| <input type="checkbox"/> Response to Notice to File Missing Parts | <input type="checkbox"/> Formal Drawing(s): [] Sheet(s) of Figure(s) [] |
| <input type="checkbox"/> Assignment & Recordation Cover Sheet | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences |
| <input type="checkbox"/> Declaration | <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) |
| <input type="checkbox"/> Power of Attorney | <input type="checkbox"/> Certified Copy of Priority Document(s) |
| <input type="checkbox"/> Application Data Sheet | <input checked="" type="checkbox"/> Copy of the return receipt postcard stamped at USPTO on March 26, 2004 |
| <input type="checkbox"/> Information Disclosure Statement & PTO-1449 <input type="checkbox"/> Copies of IDS Cited References | <input checked="" type="checkbox"/> Petition to Withdraw Holding of Abandonment Under 37 CFR § 1.181 and MPEP § 711.03(c) |
| <input type="checkbox"/> Request for Corrected Filing Receipt | <input checked="" type="checkbox"/> Copy of Amendment as filed on March 22, 2004 |
| <input type="checkbox"/> Request for Correction of Recorded Assignment | <input checked="" type="checkbox"/> Copy of the Notice of Abandonment |
| <input type="checkbox"/> Amendment/Response: [] Page(s) <input type="checkbox"/> After Final | |
| <input type="checkbox"/> Status Request | |
| <input type="checkbox"/> Revocation and Substitute Power of Attorney | |

REMARKS:

| SIGNATURE OF ATTORNEY OR AGENT | | | |
|--------------------------------|---|--------|---------------|
| Signature: |  | | |
| Attorney/Reg. No.: | Robert R. Sachs, Reg. No. 42,120 | Dated: | June 17, 2004 |


| CERTIFICATE OF FACSIMILE TRANSMISSION | | | |
|---|---|--------|---------------|
| I hereby certify that this correspondence, including the enclosures identified above, is being transmitted on the date shown below via facsimile to: BOX DAC, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 at the facsimile number indicated below. | | | |
| Signature: |  | | |
| Typed or Printed Name: | Robert R. Sachs | Dated: | June 17, 2004 |
| Facsimile Number: | 1-703-872-9306 | | |

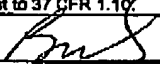
16319/08245/SF/5123185.1

| | | | |
|--|-----------|------------------------|--------------------------|
| 0001/PTO Rev. 10/95 U.S. Department of Commerce Patent and Trademark Office TRANSMITTAL FORM <i>(to be used for all correspondence during pendency of filed application)</i> | | Application Number | 09/805,321 |
| | | Filing Date | March 13, 2001 |
| | | First Named Inventor | Scott A. Hermreck |
| | | Group Art Unit Number | 3627 |
| | | Examiner Name | Bryan J. Jaketic |
| Total Number of Pages in This Submission | 18 | Attorney Docket Number | 16319-08245 |

| ENCLOSURES (check all that apply) | |
|---|---|
| <input checked="" type="checkbox"/> Fee Transmittal Form (in duplicate) <input type="checkbox"/> Check Enclosed | <input type="checkbox"/> Issue Fee Transmittal |
| <input checked="" type="checkbox"/> Return Receipt Postcard | <input type="checkbox"/> Letter to Chief Draftsperson |
| <input type="checkbox"/> Response to Notice to File Missing Parts | <input type="checkbox"/> Formal Drawing(s): [] Sheet(s) of Figure(s) [] |
| <input type="checkbox"/> Assignment & Recordation Cover Sheet | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences |
| <input type="checkbox"/> Declaration | <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) |
| <input type="checkbox"/> Power of Attorney | <input type="checkbox"/> Certified Copy of Priority Document(s) |
| <input type="checkbox"/> Application Data Sheet | <input type="checkbox"/> After Allowance Communication to Group |
| <input type="checkbox"/> Information Disclosure Statement & PTO/SB/08A <input type="checkbox"/> Copies of IDS Cited References | <input type="checkbox"/> |
| <input type="checkbox"/> Request for Corrected Filing Receipt | <input type="checkbox"/> |
| <input type="checkbox"/> Request for Correction of Recorded Assignment | <input type="checkbox"/> |
| <input checked="" type="checkbox"/> Amendment: [14] Page(s) <input type="checkbox"/> After Final | <input type="checkbox"/> |
| <input type="checkbox"/> Status Request | <input type="checkbox"/> |
| <input type="checkbox"/> Revocation and Substitute Power of Attorney | <input type="checkbox"/> |

REMARKS:

| SIGNATURE OF ATTORNEY OR AGENT | | | |
|---------------------------------------|---|--------|----------------|
| Signature: |  | | |
| Attorney/Reg. No.: | Rimma Budnitskaya, Reg. No. 48,237 | Dated: | March 22, 2004 |

| CERTIFICATE OF MAILING | | | |
|---|---|--------|----------------|
| I hereby certify that this correspondence, including the enclosures identified above, is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below. If the Express Mail Mailing Number is filled in below, then this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service pursuant to 37 CFR 1.10. | | | |
| Signature: |  | | |
| Typed or Printed Name: | Rimma Budnitskaya | Dated: | March 22, 2004 |
| Express Mail Mailing Number (optional): | | | |

16319/08245/SF/5117454.1

FEE TRANSMITTAL for FY 2004

Patent fees are subject to annual revision.

Complete if Known

| | |
|----------------------|------------------|
| Application Number | 09/805,321 |
| Filing Date | March 13, 2001 |
| First Named Inventor | Scott A. Hemreck |
| Examiner Name | Bryan J. Jaketic |
| Art Unit | 3827 |
| Attorney Docket No. | 16319-08245 |

☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT (\$ 420.00)****METHOD OF PAYMENT** (check all that apply)
☐ Check ☐ Credit Card ☐ Money Order ☐ Other ☐ None
☒ Deposit Account:
Deposit Account Number **19-2555**Deposit Account Name **Fenwick & West LLP**

The Commissioner is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☒ Credit any overpayments
☒ Charge all required fee(s) or any underpayment of fee(s) due under 37 CFR §1.16 or §1.17 during the pendency of this application
☐ Charge fee(s) indicated below, except for the filing fee

to the above-identified deposit account.

FEE CALCULATION**1. BASIC FILING FEE**

| Large Entity | | Small Entity | | Fee Description | Fee Paid |
|--------------|----------|--------------|----------|------------------------|----------|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | | |
| 1001 | 770 | 2001 | 385 | Utility filing fee | |
| 1002 | 340 | 2002 | 170 | Design filing fee | |
| 1003 | 530 | 2003 | 265 | Plant filing fee | |
| 1004 | 770 | 2004 | 385 | Reissue filing fee | |
| 1005 | 160 | 2005 | 80 | Provisional filing fee | |

SUBTOTAL (1) (\$ 0.00)**2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE**

| Total Claims | Extra Claims | | Fee from below | Fee Paid |
|--------------------|--------------|------|----------------|----------|
| | 31 | 35** | | |
| Independent Claims | 6 | 0 | 86 | 0 |
| Multiple Dependent | | | | |

| Large Entity | | Small Entity | | Fee Description |
|--------------|----------|--------------|----------|---|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | |
| 1202 | 18 | 2202 | 9 | Claims in excess of 20 |
| 1201 | 86 | 2201 | 43 | Independent claims in excess of 3 |
| 1203 | 290 | 2203 | 146 | Multiple dependent claim, if not paid |
| 1204 | 86 | 2204 | 43 | **Reissue independent claims over original patent |
| 1205 | 18 | 2205 | 9 | **Reissue claims in excess of 20 and over original patent |

SUBTOTAL (2) (\$ 0.00)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**


| Large Entity | | Small Entity | | Fee Description | Fee Paid |
|--------------|----------|--------------|----------|--|----------|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | | |
| 1051 | 130 | 2051 | 65 | Surcharge - late filing fee or oath | |
| 1052 | 50 | 2052 | 25 | Surcharge - late provisional filing fee or cover sheet | |
| 1053 | 130 | 1053 | 130 | Non-English specification | |
| 1812 | 2,520 | 1812 | 2,520 | For filing a request for ex parte reexamination | |
| 1804 | 920* | 1804 | 920* | Requesting publication of SIR prior to Examiner action | |
| 1805 | 1,840* | 1805 | 1,840* | Requesting publication of SIR after Examiner action | |
| 1251 | 110 | 2251 | 55 | Extension for reply within first month | |
| 1252 | 420 | 2252 | 210 | Extension for reply within second month | 420 |
| 1253 | 950 | 2253 | 475 | Extension for reply within third month | |
| 1254 | 1,480 | 2254 | 740 | Extension for reply within fourth month | |
| 1255 | 2,010 | 2255 | 1,005 | Extension for reply within fifth month | |
| 1401 | 330 | 2401 | 165 | Notice of Appeal | |
| 1402 | 330 | 2402 | 165 | Filing a brief in support of an appeal | |
| 1403 | 290 | 2403 | 145 | Request for oral hearing | |
| 1451 | 1,510 | 1451 | 1,510 | Petition to institute a public use proceeding | |
| 1452 | 110 | 2452 | 55 | Petition to revive - unavoidable | |
| 1453 | 1,330 | 2453 | 665 | Petition to revive - unintentional | |
| 1501 | 1,330 | 2501 | 665 | Utility issue fee (or reissue) | |
| 1502 | 480 | 2502 | 240 | Design issue fee | |
| 1503 | 640 | 2503 | 320 | Plant issue fee | |
| 1480 | 130 | 1480 | 130 | Petitions to the Commissioner | |
| 1807 | 50 | 1807 | 50 | Processing fee under 37 CFR 1.17(g) | |
| 1808 | 180 | 1808 | 180 | Submission of Information Disclosure Stmt | |
| 8021 | 40 | 8021 | 40 | Recording each patent assignment per property (times number of properties) | |
| 1809 | 770 | 2809 | 385 | Filing a submission after final rejection (37 CFR 1.129(a)) | |
| 1810 | 770 | 2810 | 385 | For each additional invention to be examined (37 CFR 1.129(b)) | |
| 1801 | 770 | 2801 | 385 | Request for Continued Examination (RCE) | |
| 1802 | 900 | 1802 | 900 | Request for expedited examination of a design application | |

Other fee (specify) _____

SUBTOTAL (3) (\$ 420.00)

*Reduced by Basic Filing Fee Paid

SUBMITTED BY**Complete (if applicable)**

| | | | | |
|-------------------|---|-----------------------------------|--------|--------------------------|
| Name (Print/Type) | Rimma Budnitskaya | Registration No. (Attorney/Agent) | 48,237 | Telephone (415) 875-2401 |
| Signature |  | | | Date |
| | | | | March 22, 2004 |

PATENT

RECEIVED
CENTRAL FAX CENTER

JUN 17 2004

OFFICIAL

IN THE UNITED STATES

PATENT AND TRADEMARK OFFICE

APPLICANT: Scott A. Hermreck, et al.
APPLICATION NO.: 09/805,321
FILING DATE: March 13, 2001
TITLE: SYSTEM AND METHOD FOR TRACKING CHARITABLE DEDUCTIONS
EXAMINER: Bryan J. Jaketic
GROUP ART UNIT: 3627
OLD ATTY.DKT.NO.: 580745.004
NEW ATTY. DKT. NO.: 16319-08245

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner For Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on the date shown below:

Dated: March 22, 2004

By: 

Rimma Budnitskaya, Reg. No. 48, 237

COMMISSIONER FOR PATENTS
P. O. BOX 1450
ALEXANDRIA, VA 22313-1450

AMENDMENT

SIR:

In response to the Office Action mailed October 23, 2003, please amend the above-identified application as follows:

App. No. 09/805,321

1

16319/08245/SF/5116423.1

PATENT

Amendments to the Claims

Please amend the claims as follows:

1. (currently amended) A computer implemented method for tracking charitable donations, said method comprising the steps of:

storing in memory data indicative of one or more donations and a tax-deductible valuation associated with each said donation for a current tax year and at least one previous tax year;

prompting a user to select one or more of said donations that has been charitably donated in one of said tax years and to indicate the tax year in which the selected donation was donated;

retrieving the tax-deductible valuation associated with said selected donation for the indicated tax year from memory; and

storing said selected donation, indicated tax year and retrieved tax-deductible valuation in said memory in association with each other.
2. (currently amended) The computer-implemented method of claim 1, wherein said donations include non-cash item donations, monetary donations, financial securities donations, mileage donations, and out-of-pocket expense donations.
3. (currently amended) The computer-implemented method of claim 1, wherein at least one of said donations comprises a non-cash item donation and said method further comprises the steps of:

receiving sales data periodically from one or more partner servers, wherein said partner servers are programmed to electronically collect sales data of items sold; and

PATENT

calculating a tax-deductible valuation in accordance with tax authority guidelines for each of said donations based on said sales data.

4. (currently amended) The computer-implemented method of claim 3, wherein said sales data is received via a communications network.

5. (currently amended) The computer-implemented method of claim 1, further comprising the steps of:

totaling the tax-deductible valuations associated with all donations for the tax year in categories based upon non-cash item, monetary, mileage, financial securities and out-of-pocket donations; and

exporting the category totals electronically into an income tax return for said tax year.

6. (currently amended) The computer-implemented method of claim 5, further comprising the steps of:

calculating whether the total amount of non-cash item charitable donations is sufficient to require filling out IRS Non-cash Charitable Contributions form 8283; and

notifying the user if IRS Non-cash Charitable Contributions form 8283 is required.

7. (currently amended) The computer-implemented method of claim 1, further comprising the step of updating said memory with a current set of data indicative of said one or more donations and a current tax-deductible valuation associated with said donations.

8. (currently amended) The computer-implemented method of claim 1, further comprising the step of presenting the user with informative data based upon said donations selected by the user.

9. (currently amended) The computer-implemented method of claim 8, wherein said informative data includes marketing information and tax tips.

PATENT

10. (currently amended) A system for determining a tax-deductible valuation of charitable donations, ~~determining a tax-deductible value of charitable donations for income tax deduction purposes for one or more tax years~~, said system comprising:

one or more partner servers having at least one data source where used items are sold, wherein said partner servers are adapted ~~programmed~~ to electronically capture sales data of items sold at said data source;

a sales history database for storing the sales data of used items; and

a system server adapted to: ~~including a memory for storing said sales data, wherein said system server is programmed to:~~

~~periodically receive said sales data from said partner server; and store said sales data in said memory;~~

periodically receive the captured sales data from the partner servers,

determine a tax-deductible valuation of the used items based on the

aggregate sales data of the used items,

receive a user selection of a used item that has been charitably donated and a year in which the donation was made,

retrieve a tax-deductible valuation associated with the selected donated item for the indicated tax year, and

provide the tax-deductible valuation to the user.

11. The system of claim 10, wherein said sales data for each item includes an item description, date of sale and amount of sale.

12. The system of claim 10, wherein said data sources are Internet auction web sites.

PATENT

13. The system of claim 10, wherein said data sources are retail shops that sell used goods.

14. The system of claim 10, wherein said sales data is electronically captured during sales transactions.

15. (currently amended) The system of claim 10, wherein said system server is accessible by users via a communications network and further programmed to provide a search engine that allows a user to search said database memory to locate said sales data corresponding to an item that has been charitably donated.

16. The system of claim 10, wherein said system server is further programmed to calculate a tax-deductible valuation for said items sold.

17. (currently amended) The system of claim 16, wherein said system server is further programmed to prompt a user to select one or more of said items sold that the user has charitably donated;

retrieve said tax-deductible valuation for said selected item; and store said tax-deductible valuation and said selected item ~~in said memory~~ in association with each other.

18. The system of claim 10, wherein said system server is further programmed to create an export file containing information pertaining to charitable donations for importing into an electronic tax preparation application.

19. (currently amended) A computer-implemented method for tracking charitable donations, said method comprising the steps of:

storing in a memory data indicative of one or more non-cash items and a tax-deductible valuation associated with each said item;

prompting a user to select any items that have been charitably donated;

PATENT

prompting a user to input any other non-cash item donations that have been charitably donated in addition to the selected items;

retrieving the tax-deductible valuation associated with each said selected item and non-cash item donation from said memory;

calculating the total tax-deductible valuation associated with all selected items and other non-cash item donations;

determining whether said tax-deductible valuation is sufficient to require filling out IRS Non-cash Charitable Contributions form 8283; and

informing the user if IRS Non-cash Charitable Contributions form 8283 is required.

20. (currently amended) The computer-implemented method of claim 19, further including the step of importing non-cash item charitable donation information into IRS Non-cash Charitable Contributions form 8283 if required.

21. (currently amended) The computer-implemented method of claim 19, further including the steps of:

receiving periodically an aggregation of sales data from one or more partner servers, wherein said partner servers having at least one data source where items are sold;

calculating a current tax-deductible valuation for said plurality of items; and

updating said memory with said current tax-deductible valuation for said plurality of items.

22. (currently amended) The computer-implemented method of claim 21, wherein said sales data includes an item description, date of sale and sale amount for each item.

23. (currently amended) The computer-implemented method of claim 19, further including the steps of:

PATENT

creating an export file comprising tax information pertaining to non-cash item charitable donations, wherein said export file is formatted in accordance with the requirements of a tax preparation application; and

exporting said file to said tax preparation application.

24. (currently amended) The computer-implemented method of claim 19, further including the steps of updating said memory with data indicative of said one or more items and a current tax-deductible valuation associated with each said item;

replacing said tax-deductible valuation associated with each said selected item with said current tax-deductible valuation; and

storing said current tax-deductible valuation and said selected item in said memory in association with each other.

25. (currently amended) A computer-implemented method for tracking charitable donations, said method comprising the steps of:

storing in a memory a first set of data indicative of one or more donations and a tax-deductible value associated with each said donation for a previous tax year;

prompting a user to select one or more donations that have been charitably donated in a current tax year;

storing said selected donation and said current tax year in said memory in association with each other; and

updating said memory with a second set of data indicative of one or more donations and a tax-deductible value associated with each said donation for said current tax year, wherein said updating comprises:

retrieving from memory said selected donation donated in said current year;

PATENT

applying a current year tax-deductible value to said selected donation; and
storing said current year tax-deductible value, said selected donation, and said current year in said memory in association with each other.

26. (currently amended) The computer-implemented method of claim 25, further comprising the steps of:

prompting the user to enter information sufficient to determine an applicable tax rate;
calculating the total of said current year tax-deductible values;
calculating the total amount of tax savings based upon said tax-deductible values and said applicable tax rate of said year; and
~~display~~ displaying said total amount of tax savings.

27. (currently amended) The computer-implemented method of claim 25, further comprising the step of updating said memory with changes to taxing authority guidelines.

28. (currently amended) The computer-implemented method of claim 25, further comprising the steps of:

providing informative data to the user depending upon input of the user.

29. (currently amended) The computer-implemented method of claim 28, wherein the informative data includes marketing information.

30-39 (cancelled).

40. (new) A computer-implemented method for determining a tax-deductible valuation of charitable donations of used items, the method comprising:
receiving, from an on-line marketplace selling used items, sales data of the used items, the sales data including a sales price of an item and an item description;

PATENT

determining a tax-deductible valuation of the used items based on aggregate sales data of the used items;
receiving a user selection of a used item that has been charitably donated and a year in which the donation was made;
retrieving a tax-deductible valuation associated with the selected donated item for the indicated tax year; and
providing the tax-deductible valuation to the user.

41. (new) A system for determining a tax-deductible valuation of charitable donations of used items, the system comprising:

a partner server adapted to receive, from an on-line marketplace selling used items, sales data of the used items, the sales data including a sales price of an item and an item description; and

a central server adapted to:

determine a tax-deductible valuation of the used items based on aggregate sales data of the used items,
receive a user selection of a used item that has been charitably donated and a year in which the donation was made,
retrieve a tax-deductible valuation associated with the selected donated item for the indicated tax year, and
provide the tax-deductible valuation to the user.

PATENT**REMARKS**

Claims 1-39 were pending in this action. Claims 30-39 have been cancelled. Claims 40 and 41 have been added.

Claim Objections

Claim 21 is objected because of a minor typographical error. Claim 21 is amended to correct the error, changing "at least data store" to "at least one data store."

Rejections Under 35 U.S.C. § 112, second paragraph

Claims 6 and 19-24 are rejected under 35 U.S.C. § 112, second paragraph.

Claims 6, 19, and 20 were rejected because they recite the limitation "IRS form 8283." Claims 6, 19, and 20 have been amended to recite "IRS Non-cash Charitable Contributions Form" instead.

Claim 23 has been rejected because it recites "said export file", which is asserted to lack an antecedent basis. Claim 23 has been amended to provide an antecedent basis for "said export file."

Rejections Under 35 U.S.C. § 101

Claims 1, 2, 7-9, 19, 20, 23-29, 36-39 are rejected under 35 U.S.C. § 101 as being directed to unpatentable subject matter. Applicants have amended claims 1-9 and 19-29 to recite a "computer-implemented method." Applicants respectfully submit that claims 1-9 and 19-29, as amended, recite statutory subject matter. Claims 36-39 have been cancelled.

Rejections Under 35 U.S.C. § 103(a)

Claims 1, 2, 5-9, 19, 20, 23-29, and 36-39 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over *CASH for Your Used Clothing* (Client Valuation Services, 2000) (hereinafter referred as "Cash") over Thomas. Although the Examiner indicated in the Office Action that the App. No. 09/805,321

PATENT

rejection of the above-referenced claims was in view of the 1999 edition of Cash, the Examiner provided a 2000 edition of the reference. Applicants respectfully traverse the rejection.

Claim 1 as amended recites:

A computer-implemented method for tracking charitable donations, said method comprising the steps of:
storing in memory data indicative of one or more donations and a tax-deductible valuation associated with each said donation for a current tax year and at least one previous tax year;
prompting a user to select one or more of said donations that has been charitably donated in one of said tax years and to indicate the tax year in which the selected donation was donated;
retrieving the tax-deductible valuation associated with said selected donation for the indicated tax year from memory; and
storing said selected donation, indicated tax year and retrieved tax-deductible valuation in said memory in association with each other.

Generally, claim 1 describes a computer-implemented method for recording and tracking charitable donations over a period of one or more years. A user is allowed to select, from a computer memory, a donation and a year in which the donation was made. A tax-deductible valuation associated with the selected donation for the tax year is retrieved. The selected donation, the corresponding tax year and the tax-deductible valuation are stored in a computer memory in association with each other. Each of amended claims 19 and 25 recite "storing in memory ..." step.

The claimed invention provides a number of advantages over conventional methods for tracking charitable deductions. For example, the claimed invention allows a taxpayer to track charitable donations over a period of multiple years in a computer implemented process.

Cash does not disclose the claimed invention. Cash is a paper manual and recordkeeping book that provides a guide to non-cash charitable donations for taxpayers (see page 2). Cash merely provides a list of charitable donations only for the current calendar year (see page 17) (emphasis added). Because Cash is a recordkeeping book, Cash only enables (and thus only teaches) taxpayers to **manually** record in the booklet individual quantities of donated items and to manually calculate the aggregate value of the donated items (see page 8) (emphasis added). Cash, however, does not disclose or suggest any computer memory structure for storing "one or more donations and a tax-deductible valuation associated with each donation."

PATENT

As the Examiner acknowledged, Cash does not disclose or suggest storing data indicative of one or more donations and a tax-deductible valuation associated with each said donation for at least one previous tax year. Rather, Cash provides a list of "certified market valuations only for the current calendar year" (see, for example, page 17). In contrast, the claimed invention, stores tax-deductible valuations for a "current tax year and at least a previous tax year" (emphasis added). Thus, since Cash does not disclose or suggest at least the "storing" step of claims 1, 19, and 25, these claims are patentable over Cash.

The addition of Thomas does not cure the defects of Cash. It appears that the Examiner did not realize that the Thomas article merely describes the very Cash reference itself. On page 2, Thomas references the Cash publication by its name *CASH for Your Used Clothing*, and on page 3, identifies "Client Valuation Services" as the publisher of *CASH for Your Used Clothing*. Indeed, Thomas discloses on page 2: "Cash For Your Used Clothing" ...provides step-by-step instruction on what to do and, most importantly, what specific items are worth." Thomas then gives some examples from Cash.

Because Thomas is merely describing Cash itself, Thomas does not disclose or suggest anything more than Cash already does. Contrary to the Examiner's assertion, Thomas does not disclose "a collection of valuation data for previous years." Again, since Thomas is nothing more than a summary of Cash and Cash does not disclose or suggest "storing in memory tax-deductible valuation associated with the current tax year and at least one previous year (emphasis added), Thomas does not disclose or suggest the claimed features.

Further, the combination of Cash and Thomas provides nothing beyond Cash itself, since Thomas merely summarizes Cash in a descriptive fashion, and makes no suggestion or recommendation as to how to extend or further implement Cash. In addition, Applicants traverse the Examiner's assertion that "it would have been obvious" to combine the teachings of Cash and Thomas. Neither of the references contains any teachings, suggestion or motivation to combine one with the other, either explicitly or implicitly. That is, there is no motivation to combine a reference with a description of the reference (e.g., one would not combine a patent with its own abstract).

Since neither of the references discloses or suggests the claimed invention, either alone or in combination, claims 1, 19, and 25 are patentable over the cited references.

PATENT

Claims 2-9, 20-24, and 26-29 depend either directly or indirectly from independent claims 1, 19, and 25 and derive their patentability at least in part from the independent claim from which they depend.

Claims 10-16 and 30-35 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Vig. Claim 10 has been amended. Claims 30-35 have been cancelled.

Claim 10, as amended, recites:

A system for determining a tax-deductible valuation of charitable donations, said system comprising:

• one or more partner servers having at least one data source where used items are sold, wherein said partner servers are adapted to electronically capture sales data of items sold at said data source;

*a sales history database for storing the sales data of used items; and
a system server adapted to:*

*periodically receive the captured sales data from the partner servers,
determine a tax-deductible valuation of the used items based on the
aggregate sales data of the used items,
receive a user selection of a used item that has been charitably donated
and a year in which the donation was made,
retrieve a tax-deductible valuation associated with the selected donated
item for the indicated tax year, and
provide the tax-deductible valuation to the user.*

Generally, amended claim 10 describes a system for electronically capturing sales data of used items from data sources and determining a tax-deductible valuation of used items based on the sales data of the used items. Each of claims 40 and 41 recites "determine a tax-deductible valuation of the used items based on the aggregate sales data of the used items."

Vig does not disclose or suggest the claimed invention. Vig merely discloses a method for artwork appraisal by which a predicted price of a target artwork for which appraisal is sought is determined based on the imaginary "normal" artwork by the same artist. Vig neither teaches nor suggests "*one or more partner servers ... adapted to electronically capture sales data of items sold at said data source*" (emphasis added). Rather, Vig teaches that once an artwork of a particular artist is sold, sales data is entered **manually** by an operator (see col. 20, lines 53-57) (emphasis added).

As the Examiner acknowledged, Vig does not disclose or suggest "*a system server adapted to determine a tax-deductible valuation of the used items based on the aggregate sales data of the used items.*" The Examiner asserts, however, that it is "common in the art to use App. No. 09/805,321

PATENT

valuations for tax purposes." Applicants respectively request that the Examiner provide a reference and/or affidavit proving that determining a tax-deductible valuation of the used items based on the aggregate sales data of the used items of which the Examiner has taken Official Notice are "capable of instant and unquestionable demonstration as to defy dispute," as required by MPEP 2144.03.


Since Vig does not disclose or suggest the features recited in claims 10, 40, and 41, these claims are patentable over Vig.

Claims 11-18 depend either directly or indirectly from independent claim 10 and derive their patentability at least in part from the independent claim from which they depend.

For these reasons, Applicants respectfully submit that all the pending claims are allowable over the cited art of record and requests that the Examiner allow the case.

Respectfully submitted,
SCOTT A. HERMRECK, ET AL.

Dated: March 22, 2004

By: 

Rimma Budnitskaya, Reg. No. 48, 237
Attorney for Applicants
Fenwick & West LLP
Silicon Valley Center
801 California Street
Mountain View, CA 94041
Tel.: (415) 875-2401
Fax: (415) 281-1350



UNITED STATES PATENT AND TRADEMARK OFFICE

COPY

0243 US

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/805,321 | 03/13/2001 | Scott A. Hermreck | 580745.004 | 1791 |

758 7590 05/24/2004

FENWICK & WEST LLP
 SILICON VALLEY CENTER
 801 CALIFORNIA STREET
 MOUNTAIN VIEW, CA 94041

EXAMINER
 JAKETIC, BRYAN J

ART UNIT 3627 PAPER NUMBER

Received at USPTO

APR 23 2004

RECEIVED

DATE MAILED: 05/24/2004

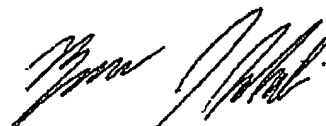
Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------|----------------|----|
| Notice of Abandonment | Application No. | Applicant(s) | |
| | 09/805,321 | HERMRECK ET AL | |
| | Examiner | Art Unit | |
| | Bryan Jaketic | 3627 | NW |

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address-

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 23 October 2003.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection. (A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:



Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

U.S. Patent and Trademark Office
PTOL-1432 (Rev. 04-01)

Notice of Abandonment

Part of Paper No. 6